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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,044	10/10/2001	Christopher Robert Cox	P66623US1	7330

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JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,044

Applicant(s)

COX ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-24 and 27-29 in Paper No. 5 is acknowledged. Claims 25 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method of booking a travel event, there being no allowable generic or linking claim.

Note: Claim 26 was previously cancelled in the Preliminary amendment (Paper No. 3) received October 10, 2001.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5, 7-14, 21, 23, 24 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 7-14 of copending Application No. 09/684,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the present claims and the co-pending claims is the present

claims claim "at least one of a front and a rear card panel" and the co-pending claims claim "a front and a rear card panel". The present claims are claiming that there could be one or more front and rear card panels. The co-pending claims are claiming that there is only one front and rear card panel. Since the present claims claim at least one front and rear card panel, one having ordinary skill in the art would conclude that it would have been obvious to provide only one set of front and rear card panels as presently disclosed in both the present claims and the co-pending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 6 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 09/684,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the present claims and the co-pending claims is that the present claims claim that the personalized and instructional information is located outside of the card region. The co-pending claims do not locate the information with respect to the card region. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the co-pending claims to provide the information at any desired location on the substrate, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- ✓ 5. Claims 2-7 and 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claims 2-7 and 9-14 lack proper antecedent basis. Applicant is claiming "an integrated magnetic strip" in the preamble of the dependent claims. This limitation has not been claimed in independent claims 1 and 8. The preamble of the dependent claims should be consistent with the preamble of the independent claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich et al. (6,159,570) in view of Stocq et al. (6,306,475).

Ulrich et al. disclose a carrier sheet (46) with an integrated card (as seen in figure 3), the carrier sheet having printed information (col. 7, lines 7-28), the information containing card information printed at a predetermined location on a front face of the sheet in a card region of the sheet and oriented to be disposed on an outer surface of a front and a rear card panel of the card to be formed (as seen in fig. 6); a release liner

(59) containing a pressure-sensitive adhesive surface (58) laminated on a back surface of the sheet and extending over the card region (as seen in fig. 4, the adhesive 58 extends over the entire back surface of the card region); a face patch of clear poly material (52 – col. 5, lines 28-30 and col. 7, lines 51-52) immovably secured over the card region on the front face of the carrier sheet; a die cut (72, 74, 76, 78 – the type of die-cut used would depend on the end result desired for removing the card) delineates the front and rear card panels disposed adjacent one another and extends through the face patch and the sheet (col. 6, lines 29-31); the die cut card panels being retained in the sheet by the pressure sensitive adhesive of the liner patch and a straight fold line (82) in the face patch between the front and rear card panels; the card being formed by peeling off the front and rear card panels from the carrier sheet with the adhesive releasing from the liner patch whereby the adhesive now lies on the back face of the front and rear card panels (as seen in fig. 8 – the adhesive is shown on the back face of the card panel as the panel is peeled away from the liner and the sheet); the panels are folded along the straight fold line to mate the back face of the panels containing the adhesive (col. 8, lines 26-51).

Regarding claim 8, Ulrich fully discloses the method of forming the carrier sheet throughout the reference and, in particular, at column 8, lines 8-59.

Ulrich disclose the claimed invention except for the liner being a siliconized liner patch. The use of silicone coatings for lining adhesives that are applied to substrates is well-known in the art of binding. Furthermore, Stocq discloses that silicone-coated release

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liners are commonly used as a backing for pressure-sensitive adhesive laminates.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ulrich's invention to include a siliconized release liner patch, as taught by Stocq, to provide the pressure-sensitive adhesive with a covering that protects it from collecting dust and other debris on its surface until the adhesive is to be used.

8. Claims 2, 3, 5-7, 9-13, 15-18, 20, 22-24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich in view of Stocq and further in view of Warther et al. (6,039,356).

Ulrich, as modified by Stocq, disclose the claimed invention except for the card being a magnetic strip card and wherein the face patch contains a magnetic strip oriented across one of the card panels and the die-cut extending through the magnetic strip at opposed edges of the card; the magnetic strip being oriented on the rear panel and disposed spaced and parallel to a lower edge of the rear panel; the printed information on the rear panel including one or more bar codes for containing specific coded information, the magnetic strip being compatible for use in an encoder/reader machine; the magnetic strip containing personalized information; and two front and rear card panels disposed in the card region and disposed spaced in side-by-side relationship.

Warther disclose printed sheet products comprising transaction cards spaced in side-by-side relationship (as seen in fig. 1) having magnetic stripes (col. 12, lines 16-28) oriented across the card panel. The card (such as element 671) is die-cut (671a) to

enable removal of the card from the sheet. The die-cut extends through the magnetic stripe (see fig. 16). Warther also discloses the use of unique codes printed on the transaction cards. The unique codes comprise machine readable bar codes encoded with information. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ulrich's invention to include magnetized indicia, as taught by Warther, providing the cards with a security element that enables the card to be authenticated and/or verified by a machine. Authentication of the card may be necessary to verify the proper identity of the user.

Regarding claims 9-11, 13 and 24, the method of forming the carrier sheet having an integrated detachable magnetic strip card is inherently taught based on the teachings of Warther's printed sheet products with magnetic strips as applied to the laminated card assembly of Ulrich.

Regarding claims 12 and 23, the step of inputting data into a computer is notoriously well-known and does not impart any patentability.

9. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ulrich in view of Stocq and Warther and further in view of Kohls (5,529,345).

Ulrich, as modified by Stocq and Warther, disclose the claimed invention except for carrier sheet having opposed detachable perforated carrier strips for feeding the paper in a high speed printer and patch application and a butterfly die cutting machine.

Kohls discloses printed identification cards with accompanying letters, the identification cards comprising front (30) and rear (32) panels comprising die-cuts (34, 36) for the removal of the cards. The letter (10) comprises printer feed holes (16) aligned with feed pins in conventional continuous feed printing equipment. The printer feed holes are positioned in removable side portions (18, 20) having perforated lines (22, 24). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ulrich's invention to include opposed detachable perforated carrier strips, as taught by Kohls, for feeding the carrier strip through a high speed printer enabling increased production of the identification cards integrated into the carrier sheet.

10. Claims 19, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich in view of Stocq and Warther and further in view of Burr et al. (4,982,337).

Ulrich, as modified by Stocq and Warther, disclose the claimed invention except for the carrier sheet being a paper sheet detachable panel of a plurality of fan-folded sheets panels that are housed in an apparatus for printing and dispensing the sheets.

Burr et al. disclose a system for dispensing sheets of paper (in this instance lottery tickets). The paper is stored in the dispensing apparatus (as seen in figure 4) in fan-fold form (see figure 5). The tickets are burst, not cut, apart for dispensing. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ulrich's invention to provide a dispensing unit for dispensing fan-folded sheets, as taught by Burr et al., to provide a secure, theft-deterrent method of storing the cards until required by the user.


Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kohls (5,509,693) discloses printed identification cards, Carlson (5,842,722) discloses printable coplanar laminates, Chess et al. (5,895,074) and (6,179,201) disclose an identification card, Yang (6,224,109) discloses a credit card, Taggart (5,687,087) discloses a card printing and dispensing system and Hansted et al. (6,299,530) disclose an integrated card and packaging.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Monica S. Carter
March 13, 2002